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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,889	03/10/2004	James Benjamin Williams	D-51	5049
21253	7590	06/15/2006	EXAMINER	
CHARLES G. CALL 68 HORSE POND ROAD WEST YARMOUTH, MA 02673-2516			HAVAN, THU THAO	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,889

Applicant(s)

WILLIAMS ET AL.

Examiner

Thu Thao Haven

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Response to Arguments

Receipt is acknowledged of the "conditional" request for a Continued Prosecution Application (CPA) filed on March 27, 2006 under 37 CFR 1.53(d) based on prior Application No. 10/797,889. Any "conditional" request for a CPA submitted as a separate paper is treated as an unconditional request for a CPA. Accordingly, the request for a CPA application is acceptable and a CPA has been established. An action on the CPA follows.

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (US 6,611,815) in view of Bove (US 2005/0154658).

Re claims **1** and **3**, Lewis teaches the method of issuing and managing investment instruments (col. 3, lines 31-58) which comprises, in combination, the steps of:

establishing an investment fund (fig. 1),

creating a security which represents a claim against and is secured by said investment fund, said security entitling its holder to receive, at one or more future maturity dates specified by said security, either a lump sum payment amount (col. 1, lines 34-45) or, at the option of said holder, to receive a sequence of annuity payments, the amount and payment date of each of said annuity payments being specified by said security (col. 2, lines 39-52),

transferring said security to a purchaser in exchange for a purchase price amount (col. 3, lines 8-51),

depositing at least a substantial portion of said purchase price amount into said fund, investing the assets of said fund so that the net asset value of said fund at said maturity date should be adequate to pay to said holder either said lump sum payment amount or an amount adequate to purchase said annuity (col. 5, line 25 to col. 6, line 65), and

on or after said maturity date, transferring either said lump sum payment amount or said annuity to said holder as elected by said holder (col. 5, lines 25-45). *In other words, Lewis discloses fixed annuity. It depends on the annuitants to choose a specific fixed annuity that includes the certainty of the dollar amount upon retirement. The specific dollar a person contributes to his/her fund then the exact amount is calculated for the years in relation to retirement. For example, Lewis discloses the account value at the end of the prior month is \$95,000.00, net investment earnings for the month are \$900.00, and the amount of the periodic (monthly) income payment is \$1,500.00, then the current amount value would be \$94,400.00.*

However, Lewis does not explicitly teach the limitation of "at the time security is created." On the other hand, Bove discloses creating bonds at the time security is created (para. 0068; figs. 1a, 2a-2b, and 7). A bond is any interest-bearing or discounted government or corporate security that obligates the issuer to pay the bondholder a specified sum of money, usually at specific intervals, and to repay the principal amount of the loan at maturity. For example, when one is buying a U.S Treasury Bond that initially worth \$50 that person knows the returns in 30 years will be \$100 when he/she initially bought the bond. With Fixed Rate Treasuries, a person will know exactly what his/her income will be and when he/she will receive interest payments. He/she will receive a steady income of semi-annual interest payments when he/she purchases Treasury notes or bonds. The initial lump sum amount of bond is readily known due to whether the bond is a short, intermediate, or long term bond. Thus, it would have been obvious to one of ordinary skill in the art to initially create a definitely amount of payment for a bond at the time security is created as discloses in Bove.

Re claim 2, Lewis teaches a method for producing and distributing investment securities (figs. 3-4) comprising, in combination, the steps of:

creating a security which comprises a contract in which the issuer of the security promises to pay to the holder of the security a predetermined guaranteed lump sum cash payment at a predetermined maturity date or to pay, in the alternative and at the option of the holder, a sequence of predetermined annuity payments at defined times (col. 5, line 25 to col. 6, line 65), and

issuing said security to a holder in advance of said maturity date in return for a purchase price payment (col. 11). *Lewis discloses a fixed annuity wherein maturity date in return for a purchase price payment is calculated. The security includes payment of the lump sum.*

However, Lewis does not explicitly teach the limitation of "security is made at the time security is first issued." On the other hand, Bove discloses security is made at the time security is first issued (para. 0068; figs. 1a, 2a-2b, and 7). A bond is any interest-bearing or discounted government or corporate security that obligates the issuer to pay the bondholder a specified sum of money, usually at specific intervals, and to repay the principal amount of the loan at maturity. For example, when one is buying a U.S Treasury Bond that initially worth \$50 that person knows the returns in 30 years will be \$100 when he/she initially bought the bond. With Fixed Rate Treasuries, a person will know exactly what his/her income will be and when he/she will receive interest payments. He/she will receive a steady income of semi-annual interest payments when he/she purchases Treasury notes or bonds. The initial lump sum amount of bond is readily known due to whether the bond is a short, intermediate, or long term bond. Thus, it would have been obvious to one of ordinary skill in the art to initially create a definitely amount of payment for a bond at the time security is first issued as discloses in Bove.

Re claim 4, Lewis teaches performing during an accumulation period after said step of transferring and before said future maturity date, of publishing, reporting or otherwise revealing both the amount of said future income and the stated current monetary value of said units or shares expressed in said specified currency (col. 12, lines 8-35). *Lewis*

discloses that the annuitant knows at all times the lump sum value of investment performance.

Re claims **5, 12-13**, and **16-17**, Lewis teaches instrument entitles its holder to redeem upon request made during said accumulation period some or all of units or shares for said stated current monetary value (col. 5, lines 40-45; col. 13, lines 20-31).

Re claims **6** and **20**, Lewis teaches single monetary unit of a specified currency payable for each of said units or shares at periodic calendar intervals is a specified integral number of dollars payable monthly, quarterly or annually for each of said units or shares (col. 6, lines 60-63; col. 5, lines 40-45). *Lewis discloses annuitants know exactly how much money they have annually.*

Re claims **7-9, 11, 18**, and **21-22**, Lewis teaches single monetary unit of specified currency payable for each of said units or shares at periodic calendar intervals is one dollar per month for each of said units or shares (col. 10, lines 33-55). *In other words, Lewis discloses annuitant knows payable amount by the amount he/she contributes to his/her monetary unit whether one dollar or percentage amount.*

Re claims **10, 15**, and **19**, Lewis teaches a method for issuing and redeeming an investment instruments that entitles is holder to receive a specified minimum annuity income after a maturity date (col. 6-7), said method comprising, in combination, the steps of:

issuing an investment instrument denominated as a number of units or shares each of which entitles the owner of said instrument to receive a specified monetary unit of a specified currency payable at periodic calendar intervals after maturity date (col. 10, lines 33-55),

paying to said owner of said instrument at said maturity date a minimum lump sum cash payment specified by instrument or, in the alternative and at the option the owner, transferring to said owner in exchange for said instrument or said lump sum payment the right to receive for each of said units or shares at least said specified monetary unit of said specified currency payable at said periodic calendar intervals (col. 9, line 54 to col. 10, line 55).

However, Lewis does not explicitly teach the limitation of "as specified in instrument as issued." On the other hand, Bove discloses as specified in instrument as issued (para. 0068; figs. 1a, 2a-2b, and 7). A bond is any interest-bearing or discounted government or corporate security that obligates the issuer to pay the bondholder a specified sum of money, usually at specific intervals, and to repay the principal amount of the loan at maturity. For example, when one is buying a U.S Treasury Bond that initially worth \$50 that person knows the returns in 30 years will be \$100 when he/she initially bought the bond. With Fixed Rate Treasuries, a person will know exactly what his/her income will be and when he/she will receive interest payments. He/she will receive a steady income of semi-annual interest payments when he/she purchases Treasury notes or bonds. The initial lump sum amount of bond is readily known due to whether the bond is a short, intermediate, or long term bond. Thus, it would have been obvious to one of ordinary skill in the art to initially create a definitely amount of payment for a bond at the time security is first issued as discloses in Bove.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Thu Thao Havan
Art Unit 3624
6/7/2006